

REMARKS/ARGUMENTS

In the Restriction/Election of Species Requirement dated August 10, 2007, the Examiner delineated four (4) major categories of inventions:

Group I (Claim 3) anionic;

Group II (Claim 4) amphoteric;

Group III (Claim 5) cationic; and

Group IV (Claim 6) non-ionic.

The Examiner further required the election of a single species.

Accordingly, Applicants provisionally elect, with traverse, Group III and the species vinylpyrrolidone/dimethylamino methacrylate copolymer also with traverse.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinctions.

All of the claims are linked with respect to utility, hair styling composition, and they all share a common nucleus, formula (1) of Claim 1 that is responsible for their activity, and as such should be examined together on the merits, especially wherein the sole disclosed utility of the product is that recited in the specification. Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. There is a commonality that exists between the groups. It is a technical relationship that involves the same features, and it is this technical feature that defines the contribution which each of the groups taken as a whole makes over the prior art.

Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim

and is in the same category of claims as the other claims. It does not matter if a dependent claim itself contains a further invention.

In chemical cases a specified group of materials which do not necessarily belong to an otherwise class can be claimed together under “Markush” practice, which sanction the claiming together operable substances which could not be defined by generic language but which nevertheless have a commonality of chemical or physical characteristics. The members of the Markush group need only possess at least one property in common which is mainly responsible for the function of the claimed relationship. In the instant application it is the structure of formula (1) as recited in Claim 1 that is common to all of the claimed compositions. The same utility in a generic sense suffices.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all the claims would not constitute a serious burden on the Office.

Applicants request that should the elected species be found allowable, the Examiner expand the search to include the non-elected inventions.

Divisional applications filed thereafter claiming the non-elected inventions should not be subject to double patenting ground of rejection 35 U.S.C. § 121, In re Joyce (Comr. Pat. 1957) USPQ 412.

Application No. 10/694,774
Reply to the Restriction/Election
of Species Requirement mailed August 10, 2007

Applicants submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)

A handwritten signature in black ink, appearing to read "Paul J. Killos", is written over a horizontal line.

Paul J. Killos
Registration No. 58,014